



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2011-0058]

RIN 0651-AC63

Revision of Patent Term Adjustment Provisions Relating to Appellate Review

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rule making.

SUMMARY: The United States Patent and Trademark Office (Office) is proposing to revise the patent term adjustment provisions of the rules of practice in patent cases. The patent term adjustment provisions of the American Inventors Protection Act of 1999 (AIPA) provide for patent term adjustment if, inter alia, the issuance of the patent was delayed due to appellate review by the Board of Patent Appeals and Interferences (BPAI) or by a Federal court and the patent was issued under a decision in the review reversing

an adverse determination of patentability. The Office is proposing to change the rules of practice to indicate that the period of appellate review under the patent term adjustment provisions of the AIPA begins when jurisdiction over the application passes to the BPAI rather than the date on which a notice of appeal to the BPAI is filed. The Office recently published the final rule (eff. date Jan 23, 2012) concerning practice before the BPAI in *ex parte* appeals and defined that jurisdiction of the appeal passes to the BPAI at the earlier of the filing of the reply brief or upon the expiration of the time in which to file a reply brief. See Rules Of Practice Before the Board of Patent Appeals and Interferences in *Ex Parte Appeals* 76 Fed. Reg. 72270, 72273 (November 22, 2011). Accordingly, for purposes of calculating patent term adjustment based upon appellate review, the impact of the rule change would be to reduce the amount of patent term adjustment awarded for successful appeal under 35 USC 154(b)(1)(C)(iii). However, the impact may be offset by potentially increasing the amount of patent term adjustment awarded for failing to issue the patent within three years of the actual filing date in the United States under 35 USC 154(b)(1)(B). The patent term adjustment award for the three year provision may increase when the examiner reopens prosecution after a notice of appeal is filed (e.g., following a pre-appeal conference or an appeal conference) and the patent issues thereafter, because the period of time between the filing of the notice of appeal and the examiner's reopening of prosecution would no longer be deducted under 35 USC 154(b)(1)(B)(ii).

COMMENT DEADLINE DATE: Written comments must be received on or before [Insert date 30 days after publication in the FEDERAL REGISTER]. No public hearing will be held.

ADDRESSES: Comments concerning this notice should be sent by electronic mail message over the Internet addressed to AC63.comments@uspto.gov. Comments may also be submitted by mail addressed to: Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, marked to the attention of Kery A. Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy. Although comments may be submitted by mail, the Office prefers to receive comments via the Internet.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal.

The comments will be available for public inspection at the Office of the Commissioner for Patents, located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia, and will be available via the Internet (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the

submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Kery A. Fries, Senior Legal Advisor, Office of Patent Legal Administration, by telephone at 571-272-7757, by mail addressed to: Box Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450, marked to the attention of Kery A. Fries.

SUPPLEMENTARY INFORMATION: The Uruguay Round Agreements Act (URAA) amended 35 U.S.C. 154 to provide that the term of a patent ends on the date that is twenty years from the filing date of the application, or the earliest filing date for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c). See Pub. L. 103-465, § 532(a)(1), 108 Stat. 4809, 4983-85 (1994). The URAA also contained provisions, codified at 35 U.S.C. 154(b), for patent term extension due to certain examination delays. Under the patent term extension provisions of 35 U.S.C. 154(b) as amended by the URAA, an applicant is entitled to patent term extension for delays due to interference, secrecy order, or successful appellate review. See 35 U.S.C. 154(b) (1995). The Office implemented the patent term extension provisions of the URAA in a final rule published in April of 1995. See Changes to Implement 20-Year Patent Term and Provisional Applications, 60 FR 20195 (Apr. 25, 1995) (twenty-year patent term final rule).

The American Inventors Protection Act of 1999 (AIPA) further amended 35 U.S.C. 154(b) to expand the list of administrative delays which may give rise to patent term adjustment (characterized as “patent term adjustment” in the AIPA). See Pub. L. 106–113, 113 Stat. 1501, 1501A–552 through 1501A–591 (1999). Specifically, under the patent term adjustment provisions of 35 U.S.C. 154(b) as amended by the AIPA, an applicant is entitled to patent term adjustment for the following reasons: (1) if the Office fails to take certain actions during the examination and issue process within specified time frames (known as the “A” provision, being in 35 U.S.C. 154(b)(1)(A)); (2) if the Office fails to issue a patent within three years of the actual filing date of the application in the United States (known as the “B” provision, being in 35 U.S.C. 154(b)(1)(B)); and (3) for delays due to interference, secrecy order, or successful appellate review (known as the “C” provision, being in 35 U.S.C. 154(b)(1)(C)). See 35 U.S.C. 154(b)(1). The Office implemented the patent term adjustment provisions of 35 U.S.C. 154(b) as amended by the AIPA in a final rule published in September of 2000. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 FR 56365 (Sept. 18, 2000) (patent term adjustment final rule).

The patent term adjustment provisions of the AIPA apply to original (i.e., non-reissue) utility and plant applications filed on or after May 29, 2000. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 FR at 56367. The patent term extension provisions of the URAA (for delays due to secrecy

order, interference or successful appellate review) continue to apply to original utility and plant applications filed on or after June 8, 1995, and before May 29, 2000. See id.

In April 2011 the Office proposed to revise the patent term extension and adjustment provisions of the URAA and AIPA to provide, with certain exceptions, that the reopening of prosecution by an examiner would be considered a “decision in the review reversing an adverse determination of patentability,” since in many such situations the reopening of the application after a notice of appeal has been filed is the result of a decision in the pre-BPAI review that there is some weakness in the adverse patentability determination from which the appeal was taken, making it appropriate to treat such situations as a “decision in the review reversing an adverse determination of patentability” under the patent term adjustment and extension provisions. See Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements, 76 FR 18990 (Apr. 6, 2011). The Office received several comments suggesting that a better approach would be to treat the appellate review period as beginning when jurisdiction passes to the BPAI, rather than on the date a notice of appeal to the BPAI was filed. This approach would give applicants the possibility of obtaining patent term adjustment under the “B” provision for Office delays during the pre-BPAI process (including when prosecution is reopened). Specifically, the Office would not subtract from the “B” period the period of time from the filing of the notice of appeal to the earlier of the filing of a reply brief or the expiration of the period to file the reply brief. The Office has decided to seek public comment on this approach. Accordingly, the Office is proposing to

change its interpretation of the appellate review language of the “B” provision (35 U.S.C. 154(b)(1)(B)(ii)), and provide that appellate review begins on the date on which jurisdiction over the application passes to the Board of Patent Appeals and Interferences under 37 CFR 41.35 (rather than the date on which a notice of appeal under 35 U.S.C. 134 was filed as in the current rule).

The “B” provision provides for the possibility of patent term adjustment “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States.” 35 U.S.C. 154(b)(1)(B). The “B” provision also provides that certain periods are not included in determining whether the issue of a patent is delayed due to the failure of the Office to issue the patent within three years of its filing date, one of such periods being “any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court.”

35 U.S.C. 154(b)(1)(B)(ii). Since the period of appellate review by the BPAI or a Federal court is not included in determining whether the issue of a patent is delayed due to the failure of the Office to issue the patent within three years of its filing date under the “B” provision, a later beginning of the appellate review by the BPAI, as now being proposed, would result in the possibility of a greater period of patent term adjustment under the “B” provision vis-à-vis the Office’s interpretation of this provision in 2000.

The “C” provision provides for the possibility of patent term adjustment “if the issue of an original patent is delayed due to” inter alia “appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability.” 35 U.S.C. 154(b)(1)(C). The Office is also proposing to change its interpretation of the appellate review language of the “C” provision (35 U.S.C. 154(b)(1)(C)(iii)). To change the interpretation of the appellate review language of the “B” provision without also changing the appellate review language of the “C” provision would be difficult to justify because it would require the Office to interpret the same statutory term, “appellate review by the Board,” appearing in two closely related provisions, in two different ways. Doing so violates the well-recognized canon of statutory interpretation that the same terms appearing in related statutory provisions are to be given the same meaning. See, e.g., Yi v. Fed. Bureau of Prisons, 412 F.3d 526, 531 (4th Cir. 2005). Since the period of adjustment under the appellate review portion of the “C” provision is the period of appellate review by the BPAI or by a Federal court, a later beginning of the appellate review by the BPAI, as now being proposed, would result in the possibility of a lesser period of patent term adjustment under the “C” provision vis-à-vis the Office’s interpretation of this provision in 2000.

The Office recognizes that there is a question as to whether the URAA should be considered instructive in interpreting the “C” provisions of 35 U.S.C. 154(b) as amended by the AIPA. The Office has, until now, treated the AIPA patent term

adjustment provisions as an extension of, rather than a replacement for, the URAA patent term extension provisions. The AIPA (like the URAA) provided patent term adjustment for delays caused by secrecy order, interference proceedings, and successful appellate review (the “C” provision), with the legislative history characterizing this provision as the “existing” provisions. See H.R. Rep. No. 106-464, at 125 (1999). The appellate review provision of the URAA provides for patent term extension if “the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability,” and specifically defines the period of appellate review as “includ[ing] any period beginning on the date on which an appeal is filed under section 134 or 141 of this title, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant.” See 35 U.S.C. 154(b)(2) and 154(b)(3)(A) as amended by § 532(a) of the URAA, 108 Stat. at 4984.

Since the appellate review provisions of the AIPA use the same phrase as the URAA appellate review provision (“appellate review by the Board of Patent Appeals and Interferences or by a Federal court”) and the AIPA provides no alternative definition of the date that is the beginning of the period of appellate review by the BPAI or by a Federal court, the Office originally interpreted the beginning of the pendency of “appellate review by the Board of Patent Appeals and Interferences or by a Federal court” (35 U.S.C. 154(b)(1)(C)(iii)) using the guidance provided in 35 U.S.C. 154(b)(3)(A) as amended by the URAA for the beginning of the period of appellate

review, namely that the beginning of the period of appellate review is the date on which an appeal to the BPAI is filed under 35 U.S.C. 134. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 FR, 17215, 17218 and 17227 (Mar. 31, 2000). The USPTO did not receive any comment on its original interpretation of this provision. Finally, the U.S. Court of Appeals for the Federal Circuit has also in passing characterized the “C” provision of the 35 U.S.C. 154(b)(1)(C) as the patent term extension provisions of the URAA. See Wyeth v. Kappos, 591 F.3d 1364, 1372 (Fed. Cir. 2010) (“Before enactment of the AIPA, section 154(b) only provided extensions for the category that now fall under the C adjustments”).

The Office has reconsidered its prior position and now believes that the better view is that the URAA’s express definition of the appellate-review period should not carry over to the “C” provision of AIPA, because the URAA definition is completely absent from the AIPA. It is a canon of statutory construction that Congress is presumed to intend its statutory amendments to have “real and substantial effect.” Intel Corp. v. Advanced Micro Devices, Inc., 542 U.S. 241, 258-59 (2004). Thus, when Congress deletes a term or provision from a statute, it is inappropriate to read that term or provision back into the statute. See id. (holding that because Congress amended 28 U.S.C. 1782(a) to delete the requirement that proceedings covered by the statute be “pending,” Court rejected view that this statute comes into play only for pending proceedings). Likewise, the Office now believes that it is not appropriate to read back into the “C” provision of the AIPA the appellate-review definition that

Congress deleted from Title 35. Therefore, the Office is also proposing to change its interpretation of the appellate review language of the “C” provision (35 U.S.C. 154(b)(1)(C)(iii)), and also to provide that appellate review begins on the date on which jurisdiction over the application passes to the BPAI under 37 CFR 41.35 (rather than the date on which a notice of appeal under 35 U.S.C. 134 was filed as in the current rule).

The AIPA also sets forth a number of conditions and limitations on any patent term adjustment accrued under 35 U.S.C. 154(b)(1). Specifically, 35 U.S.C. 154(b)(2)(C) provides, in part, that “[t]he period of adjustment of the term of a patent under [35 U.S.C. 154(b)(1)] shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application” and that “[t]he Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.” 35 U.S.C. 154(b)(2)(C)(i) and (iii). The rules of practice (37 CFR 41.37) require that an appeal brief be filed within two months from the date of filing of the notice of appeal under 35 U.S.C. 134 and 37 CFR 41.31. An applicant, however, may delay or prevent the passing of jurisdiction of the application to the BPAI by: (1) obtaining an extension of time to file the appeal brief; (2) filing an appeal brief that does not comply with the requirements of 37 CFR 41.37; or (3) seeking further prosecution before the examiner by filing a request for continued examination under 37 CFR 1.114. Therefore, the Office is proposing, under its authority under 35 U.S.C. 154(b)(2)(C), to provide that

the failure to file an appeal brief in compliance with 37 CFR 41.37 within two months from the date on which a notice of appeal to the BPAI was filed under 35 U.S.C. 134 and 37 CFR 41.31 constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Part 1, is proposed to be amended as follows:

Section 1.703: Section 1.703(b)(4), which defines the period of appellate review in 35 U.S.C. 154(b)(1)(B)(ii), is amended to define this period as the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the BPAI under § 41.35 of this title and ending on the date of a final decision in favor of the applicant by the BPAI or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145. Section 1.703(b)(4) currently defines this period as beginning on the date on which a notice of appeal to the BPAI was filed under 35 U.S.C. 134 and § 41.31.

Section 1.703(e), which defines the period of appellate review in 35 U.S.C. 154(b)(1)(C)(iii), is amended to define this period as the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the BPAI under § 41.35 of this title and ending on the date of a final

decision in favor of the applicant by the BPAI or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145. Section 1.703(e) currently defines this period as beginning on the date on which a notice of appeal to the BPAI was filed under 35 U.S.C. 134 and § 41.31.

Section 1.704: Section 1.704(c) is amended to provide that the failure to file an appeal brief in compliance with § 41.37 within two months from the date on which a notice of appeal to the BPAI was filed under 35 U.S.C. 134 and § 41.31 constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Section 1.704(c) would also provide that in such a case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date two months from the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date an appeal brief was filed in compliance with § 41.37 or a request for continued examination was filed in compliance with § 1.114.

Rule Making Considerations:

A. Regulatory Flexibility Act: For the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration

that changes proposed in this notice will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b).

The changes to the rules of practice proposed in this notice: (1) revise the provisions that define the beginning and ending dates of the period of appellate review under 35 U.S.C. 154(b)(1)(B)(ii) and 154(b)(1)(C)(iii) to provide that this period begins on the date on which jurisdiction over the application passes to the BPAI under 37 CFR 41.35; and (2) provide that the failure to file a proper appeal brief within two months from the date on which a notice of appeal to the BPAI was filed, as required by 35 U.S.C. 134, constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. This notice does not propose to add any additional requirements (including information collection requirements) or fees for patent applicants or patentees.

The proposed changes to 37 CFR 1.703(b)(4) and (e) merely reinterpret the beginning and ending dates of the period of appellate review under 35 U.S.C. 154(b)(1)(B)(ii) and 154(b)(1)(C)(iii). They do not impose any additional burden on applicants. The proposed change to 37 CFR 1.704(c) specifies that the failure to file a proper appeal brief within two months from the date on which a notice of appeal to the BPAI was filed, as required by 35 U.S.C. 134, constitutes failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application would not have will not have a significant economic impact on a substantial number of small entities because: (1) applicants are not entitled to patent term adjustment for

examination delays that result from their delay in prosecuting the application (35 U.S.C. 154(b)(2)(C)(i) and 37 CFR 1.704(a)); and (2) applicants may avoid any consequences from this provision simply by filing an appeal brief in compliance with 37 CFR 41.37 (or filing a request for continued examination under 37 CFR 1.114) within two months from the date on which a notice of appeal to the BPAI was filed as required by 35 U.S.C. 134 and § 41.31.

For the foregoing reasons, neither of the changes proposed in this notice will have a significant economic impact on a substantial number of small entities.

B. Executive Order 12866 (Regulatory Planning and Review): This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

C. Executive Order 13563 (Improving Regulation and Regulatory Review): The Office has complied with Executive Order 13563. Specifically, the Office has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided on-line

access to the rule making docket; (7) attempted to promote coordination, simplification and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

D. Executive Order 13132 (Federalism): This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

E. Executive Order 13175 (Tribal Consultation): This rule making will not: (1) have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

F. Executive Order 13211 (Energy Effects): This rule making is not a significant energy action under Executive Order 13211 because this rule making is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

G. Executive Order 12988 (Civil Justice Reform): This rule making meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

H. Executive Order 13045 (Protection of Children): This rule making does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

I. Executive Order 12630 (Taking of Private Property): This rule making will not effect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

J. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), prior to issuing any final rule, the United States Patent and Trademark Office will submit a report containing the final rule and other required information to the U.S. Senate, the U.S. House of Representatives and the Comptroller General of the Government Accountability Office. The changes in this notice are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this notice is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

K. Unfunded Mandates Reform Act of 1995: The changes proposed in this notice do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

L. National Environmental Policy Act: This rule making will not have any effect on the quality of environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

M. National Technology Transfer and Advancement Act: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rule making does not contain provisions which involve the use of technical standards.

N. Paperwork Reduction Act: The rules of practice pertaining to patent term adjustment and extension have been reviewed and approved by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.) under OMB control number 0651-0020. The changes to the

rules of practice proposed in this notice: (1) revise the provisions that define the beginning and ending dates of the period of appellate review under 35 U.S.C. 154(b)(1)(B)(ii) and 154(b)(1)(C)(iii) to provide that this period begins on the date on which jurisdiction over the application passes to the BPAI under 37 CFR 41.35; and (2) provide that the failure to file a proper appeal brief within two months from the date on which a notice of appeal to the BPAI was filed, as required by 35 U.S.C. 134, constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. This notice does not propose to add any additional requirements (including information collection requirements) or fees for patent applicants or patentees. Therefore, the Office is not resubmitting information collection packages to OMB for its review and approval because the changes proposed in this notice do not affect the information collection requirements associated with the information collections approved under OMB control number 0651-0020 or any other information collections.

Notwithstanding any other provision of law, no person is required to respond to nor shall any person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.

For the reasons set forth in the preamble, 37 CFR part 1 is proposed to be amended as follows:

PART 1 - RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

2. Section 1.703 is amended by revising paragraph (b)(4) and (e) to read as follows:

§ 1.703 Period of adjustment of patent term due to examination delay.

* * * * *

(b) * * *

(4) The number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Board of Patent Appeals and Interferences under § 41.35 of this title and ending on the date of the last decision by

the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

* * * * *

(e) The period of adjustment under § 1.702(e) is the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Board of Patent Appeals and Interferences under § 41.35 of this title and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

* * * * *

3. Section 1.704 is amended by redesignating paragraph (c)(9) through (c)(11) as (c)(10) through (c)(12), respectively, and adding a new paragraph (c)(9) to read as follows:

§ 1.704 Reduction of period of adjustment of patent term.

* * * * *

(c) * * *

(9) Failure to file an appeal brief in compliance with § 41.37 within two months from the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date two months from the date on which a

notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date an appeal brief in compliance with § 41.37 or a request for continued examination in compliance with § 1.114 was filed;

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Date: December 15, 2011

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

[FR Doc. 2011-33150 Filed 12/27/2011 at 8:45 am; Publication Date: 12/28/2011]